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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/802,026 | 03/08/2001 | Robert R. Champion | 1912-001 | 4695 |
| 9629 | 7590 | 12/14/2005 | EXAMINER | |
| MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | LIVERSEEDGE, JENNIFER L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3628 | |

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------|-----------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/802,026 | CHAMPION ET AL. |
| | Examiner | Art Unit |
| | Jennifer Liversedge | 3628 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 July 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/802,026 (March 8, 2001) filed on July 11, 2005.

The amendment contains original claims: 3-8, 13-14

The amendment contains amended claims: 1, 9-12, 15

The following claim was canceled: 2

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, and 3-10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,418,419 B1 to Nieboer et al. (further referred to as Nieboer).

Regarding claim 1, Nieboer discloses a computerized method (column 1, lines 7-13) comprising the steps of associating each of one or more investment identifiers with an investment amount and one or more asset category identifiers (column 2, lines 27-

58); and associating each of the one or more asset category identifiers with (a) a corresponding allocation parameter, and (b) a corresponding response parameter (column 1, lines 15-22, column 2, lines 13-17 and lines 27-33); wherein each of the respective investment identifiers uniquely specifies a corresponding investment contract (column 2, lines 1-55); wherein each of respective asset category identifiers uniquely specifies an investment asset category (column 2, lines 56-59; Figures 4-14); wherein the allocation parameter specifies an allocation amount to be indexed to the corresponding asset category identifier (column 2, lines 34-55); and wherein the response parameter specifies a relationship between (i) the allocation amount, and (ii) subsequent price, percentage return, and/or relative valuation changes in, and/or net worth changes relating to, the corresponding investment asset category (column 2, lines 6-22; column 3, lines 10-15; column 5, lines 63-67; column 6, lines 42-44 and lines 63-67).

Regarding claim 3, Nieboer discloses the computerized method (column 1, lines 7-13) further comprising the steps of receiving an input enabling a determination of the investment identifier, and at least one of (a) the investment amount; (b) the one or more asset category identifiers; (c) the allocation parameter to be associated with each of the one or more asset category identifiers; and (d) the response parameter to be associated with each of the one or more asset category identifiers (column 2, lines 1-58).

Regarding claim 4, Nieboer discloses the computerized method wherein a computerized mechanism associates each of the one or more investment identifiers with the one or more corresponding asset category identifiers, and associates each of the one or more asset category response parameter (column 2, lines 56-58), and wherein the input to the computing mechanism is received using at least one of (a) an electronic device coupled over the Internet to the computing mechanism; and (b) a telephonic device coupled over the PSTN (public switched telephone network) to an IVR (interactive voice response) system and/or a speech recognition system, wherein the IVR and/or speech recognition system is coupled to the computing mechanism (column 1, lines 5-13; column 5, lines 28-34).

Regarding claim 5, Nieboer discloses the computerized method wherein the step of receiving an input includes receiving one or more templates corresponding to a given investment identifier, each of respective templates setting forth a corresponding predefined allocation parameter and a corresponding predefined response parameter for each of one or more asset category identifiers (column 3, lines 40-48; column 4, lines 5-10).

Regarding claim 6, Nieboer discloses the computerized method further including the step of receiving a template selection, wherein the template selection uniquely specifies one of the received templates corresponding to the given investment identifier;

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and the template so selected is then applied to an electronic investment contract associated with the given investment identifier (column 6, lines 49-58).

Regarding claim 7, Nieboer discloses the computerized method further including the step of inputting a predefined condition to be associated with a specified one of the received templates, such that the specified one of the received templates is automatically applied to an electronic investment contract associated with the given investment identifier upon occurrence of the predefined condition (column 2, lines 5-12; column 3, lines 49-58; column 6, lines 24-26).

Regarding claim 8, Nieboer discloses the computerized method wherein the predefined condition is at least one of (a) an occurrence of a specified price, percentage return, and/or relative valuation of, and/or change in net worth relating to, one or more investment asset categories; (b) an occurrence of a specified date and/or time; and (c) an occurrence of an event (column 3, lines 59-64; column 4, lines 15-21; column 6, lines 63-67).

Regarding claim 9, Nieboer discloses the method wherein each of the one or more corresponding electronic investment contracts is held by a corresponding investor (column 2, lines 1-5; column 3, lines 3-7 and lines 37-39; column 3, lines 49-65; column 5, lines 64-67; column 6, lines 63-67).

Regarding claim 10, Nieboer discloses the method further including the step of determining an overall monetary value for one or more of said corresponding electronic investment contracts (column 2, lines 27-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer. Nieboer discloses the method wherein each corresponding electronic investment contract defines a financial relationship between said corresponding investor and a contract administrator (column 1, lines 23-26 and lines).

Nieboer does not disclose such that, upon demand, the contract administrator shall convey the overall monetary value of the contract to said investor. However, it is

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old and well known that contract administrators convey the overall monetary value of a contract to an investor. It would be obvious to convey overall monetary values to investors, the motivation being that investors both want and need to know the value of their accounts.

Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nieboer as applied to claim 9 above, and further in view of "Strategic asset allocation and international investing" by Richard Grinold and Richard Meese in the Journal of Portfolio Management in the Fall of 2000 (further referred to as Grinold).

Regarding claim 12, Nieboer does not disclose the method further including the step of calculating an aggregate position for an asset category by consolidating allocation parameters and response parameters associated with said asset category. However, Grinold discloses the method further including the step of calculating an aggregate position for an asset category by consolidating allocation parameters and response parameters associated with said asset category (page 1, line 12 – page 2, line 45; page 4, line 27 – page 5, line 6; page 6, lines 20-26). It would be obvious to one of ordinary skill in the art to combine the calculating of an aggregate for an asset category as disclosed by Grinold with the electronic portfolio mechanism as disclosed by Nieboer. The motivation would be to sum the value of each of the categories in order to create efficient trading and reporting.

Regarding claim 13, Nieboer does not disclose the method further including the step of calculating aggregate positions for each of a plurality of asset categories. However, Grinold discloses the method further including the step of calculating aggregate positions for each of a plurality of asset categories (page 1, lines 12-15; page 2, lines 25-29; page 4, lines 27- page 5, line 6; page 6, lines 20-26). It would be obvious to one of ordinary skill in the art to combine the calculating of an aggregate for the plurality of asset categories as disclosed by Grinold with the electronic portfolio mechanism as disclosed by Nieboer. The motivation would be to sum the value of each of the categories in total in order to create efficient trading and reporting and to value the overall position.

Regarding claim 14, Nieboer discloses the method further including the step of using the calculated aggregate positions to automatically generate purchase and/or sale orders for any of (a) futures contracts, (b) swaps, (c) contracts for differences, (d) securities, and (e) other financial instruments (column 2, lines 56-58; column 4, lines 15-21).

Regarding claim 15, Nieboer does not disclose the method further including the step of using the calculated aggregate positions to generate purchase and/or sales orders so as to enable the contract administrator to hedge the payment obligation. However, Grinold discloses the method further including the step of using the calculated aggregate positions to generate purchase and/or sales orders so as to enable the

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contract administrator to hedge the payment obligation (page 1, line 18 – page 2, line 29). It would be obvious to one of ordinary skill in the art to combine the use hedging as disclosed by Grinold with the electronic portfolio mechanism as disclosed by Niebore. The motivation would be to minimize risk using a common financial tool.

Response to Arguments

The Examiner has read and considered the Applicant's remarks regarding definitions of words as used in the claims and the specification and the follow Office Action has been made in accordance with said remarks.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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